

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/827,465
Filing Date: April 19, 2004
Applicant: Terry L. Turner et al.
Group Art Unit: 3721
Examiner: Nathaniel C. Chukwurah
Title: POWER TOOL WITH BATTERY PACK EJECTOR
Attorney Docket: 0275MU-000510/COB

Mail Stop Reply Brief – Patents
Director of the U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF

Dear Sir:

In response to the Examiner's Answer dated October 30, 2007, please consider the following.

ARGUMENT

The Examiner, in his Answer, has failed to meet the standard the Supreme Court has outlined in KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 USPQ2d 385 (2007). The Examiner in his Answer, on page 9, paragraphs 3 and 4, provides in each paragraph a one sentence conclusion why the two references are combinable with one another.

In KSR, the Court stated:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See, In re Kahn, 441 F.3d. 977 at 988 (CA Fed. 2006) (“[R]ejections on obvious grounds cannot be sustained by mere conclusory statements; instead, these must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Here, the Examiner again has failed to provide any explicit reasoning as to why the combination is obvious. There is no rationale underpinning as to why, as required by KSR, only the Examiner’s conclusion.

The Examiner has failed to provide any rationale underpinning as to why one skilled in the art would substitute an extended spring for a compression spring when they teach away from one another. The Examiner has failed to provide any rationale underpinning how one skilled in the art would substitute a compression spring operation for an extended spring operation. The Examiner has failed to provide any rationale underpinning as to why one would substitute one mechanism for the other when the substitution would render the ejection mechanism inoperable.

The Examiner’s failure to provide this rationale underpinning to support his conclusion of obviousness flies in the face of the Supreme Court’s KSR decision. Accordingly, the Examiner’s naked conclusions cannot support an obviousness rejection. Thus, the Examiner’s failure to provide any rationale underpinning cannot withstand the KSR analysis. Thus, the Examiner’s rejection must be overturned.

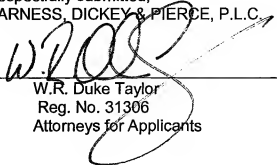
CONCLUSION

Applicants respectfully submit that the Examiner has failed to show the present claims are obvious in view of Mooty et al. and Maeda et al.

Accordingly, reversal of the final rejection of Claims 23-38 and allowance of these claims is respectfully requested.

Respectfully submitted,
HARNES, DICKEY & PIERCE, P.L.C.

By: _____


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